

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application: Richard J. MACKOOL

Art Unit: 3763

Serial Number: 10/825,046

Examiner: Melissa A. McCORKLE

Filed: 04/15/2004

Confirmation No: 7400

Title: STERILE TUBING SHEATH

Attorney Docket: 103471-51150

Customer No: 26345

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Commissioner for Patents
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Alexandria, VA 22313-1450

RESPONSE

Sir:

Responsive to the Office Action dated March 6, 2006, please consider the following:

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS:

The courtesies extended by the Examiner and her supervisor in consenting to and participating in the telephonic interview of April 18, 2006 are acknowledged and appreciated.

Claims 1-12 are pending of which claims 6-11 are withdrawn.

Claims 1-5 were rejected under 35 USC 102 (b) as being anticipated by Bailly et al (EP 0570255). Claim 12 was rejected under 35 USC 103 over Bailly et al (EP 0570255) in view of Knoll et al. (US 5,242,398). The rejections are respectfully traversed.

Bailly et al pertain to dentist surgery, not eye surgery devices, and to that extent constitutes non-analogous art. Just because skilled artisans in the art of dentist surgery may take steps to prevent contamination of some of their tubing does not mean that skilled artisans in the field of eye surgery would turn to their technique so as to adopt it for their own practice.

Bailly et al show a cover 16 with one end connected to an adaptor 4, while the other end is free.

As best understood, the Examiner's position is that Bailly et al's cover 16 is connectable to nozzle 7 (although it accommodates insertion of conduit 4). Figs. 2a, 2b, 2c and 3 of Bailly, however, show the nozzle 7 spaced away out of contact from the cover 16 and therefore not disclosed to be connectable to it. There is no reason to so connect, even if it were feasible since either the cover 16 would not be integrally formed with the adaptor 4 or the upstream end of the conduit 4 would become exposed to environment contamination.

Pending independent Claims 1 and 9 recite a sterile, tubular sheath whose distal end is secured to a hollow extension tube and recite that the sheath is secured to the aspiration tube (at a location spaced from the distal end of the aspiration tube). The concept of connection to more than one connection location is completely absent from Bailly et al.


If there were no connection of the sheath to a location spaced from the distal end of the aspiration tube, in contrast to the recitation of claim 1, then the sheath would not be held taut and thus be free to contract into a non-expanded condition. Bailly et al.'s cover lacks such a characteristic entirely with respect to its cover and is thus deficient vis a vis the recitation of claim 1.

Knoll et al. does not make up for this deficiency of Bailly et al. Knoll et al relates to a catheter assembly, thereby being non-analogous art to both Bailly et al. and the claimed invention. Knoll et al. lacks disclosure of the concept of an expanded sheath that is secured at two spaced apart locations. Therefore, claim 12 is patentable over the combination of Bailly et al. and Knoll et al.

Withdrawal of the claim rejections is requested.

Respectfully submitted,

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